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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,013	01/21/2004	Bruce A. Benfield	SVL920030105US1	6192
47069 7590 09/27/2007 KONRAD RAYNES & VICTOR, LLP ATTN: IBM54 315 SOUTH BEVERLY DRIVE, SUITE 210 BEVERLY HILLS, CA 90212			EXAMINER TAYLOR, NICHOLAS R	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 09/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,013

Applicant(s)

BENFIELD ET AL.

Examiner

Nicholas R. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/17/04; 1/21/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 have been examined and are rejected.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 12, and 18 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claims recite the limitation "the three-part composite key," for which there is insufficient antecedent basis.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the "article of manufacture" would reasonably be interpreted by one of ordinary skill in the art as failing to fall within a statutory category of invention, because applicant's disclosure defines "article of manufacture" to include propagated signals (e.g., "transmission media"; see page 18).

Thus, in the context of the disclosure and claims in question, one of ordinary skill in the art would reasonable interpret the claimed subject matter to encompass intangible embodiments. As such, the claimed invention is not limited to a process, machine, manufacture, or composition of matter. Thus, the claimed limitations are not limited to statutory subject matter and are therefore nonstatutory.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ingersoll et al. (U.S. Patent 7,047,488).

8. As per claims 1, 19, and 17, Ingersoll teaches a method for managing schemas, comprising:

registering a schema and one or more associated schema documents;
automatically generating a schema information document based on the schema and the one or more associated schema documents; and (Ingersoll, col. 4, lines 8-24 and 41-48; col. 5, lines 1-44)

processing a request to be performed on at least one of the schema, an associated schema document, and the schema information document (Ingersoll, e.g., col. 5, line 61 to col. 6, line 11; see fig. 14).

9. As per claims 2 and 10, Ingersoll teaches the system further comprising:

storing an identifier for the schema, wherein the identifier includes a three-part composite key and an optional unique name; and storing identifiers for each of the one or more associated schema documents, wherein each identifier includes a three-part composite key (Ingersoll, col. 5, lines 1-35 where the attributes are described; see also col. 5, lines 44-54 and col. 8, lines 6-29).

10. As per claims 3 and 11, Ingersoll teaches the system further wherein at least one part of the three-part composite key includes a version identifier (Ingersoll, col. 5, lines 1-43, where version identification is used; see also col. 8, lines 6-29).

11. As per claims 4, 12, and 18, Ingersoll teaches the system further wherein the schema and the one or more schema documents are stored and further comprising: when a copy of the schema document has already been stored, discarding the schema document;

and when a portion of the three-part composite key of the schema document to be stored matches a three-part composite key of a schema document that has already been stored, storing the schema document with a version identifier (Ingersoll, col. 5,

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lines 35-42, where a version identifier is assigned; see also col. 4, lines 1-35 and 44-62).

12. As per claims 5 and 13, Ingersoll teaches the system further wherein the request comprises deregistering the schema (Ingersoll, col. 5, line 61 to col. 6, line 3).

13. As per claims 6 and 14, Ingersoll teaches the system wherein the request comprises lookup of a schema and further comprising:

when there is one matching schema, returning the matching schema; when there are multiple matching schemas, applying a filter to identify one matching schema; and when there is no matching schema, applying at least one of a user-defined technique and a system defined technique to find a matching schema (Ingersoll, col. 6, line 63 to col. 7, line 27 and figs. 6 and 7).

14. As per claims 7 and 15, Ingersoll teaches the system further wherein the request comprises replacement of at least one of the schema and one of the schema documents and further comprising:

replacing the schema if a new schema is backward compatible; and replacing one of the schema documents if a new schema document is backward compatible (Ingersoll, col. 5, line 61 to col. 6, line 11, where the schema is validated for compatibility before replacement).

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15. As per claims 8, 16, and 20, Ingersoll teaches the system further wherein the request comprises access of at least one of the schema and one of the schema documents and wherein access is granted based on an access privilege associated with a user and the schema (Ingersoll, e.g., see the user and admin privilege type associated with fig. 14).

16. As per claim 19, Ingersoll teaches the system further wherein the request comprises one of deregistering the schema, lookup of a schema, and replacement of at least one of the schema and one of the schema documents (Ingersoll, col. 5, line 61 to col. 6, line 3).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes:

U.S. PGPub 2003/0156108, which describes a method of parsing a digital item into a resource and description of a resource;

U.S. Patent No. 2004/0177039, which describes a method of maintaining an XML schema repository; and

U.S. PGPub 20050120029, which describes a method for creating and managing XML Schema collections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-

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3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NT 9-22-07

Nicholas Taylor
Examiner
Art Unit 2141


JASON CARDONE
SUPERVISORY PATENT EXAMINER